



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,371	06/23/2003	Gholam A. Peyman	44770B	7058

29180 7590 02/02/2007
BELL, BOYD, & LLOYD LLP
P.O. BOX 1135
CHICAGO, IL 60690

EXAMINER

WILLSE, DAVID H

ART UNIT	PAPER NUMBER
----------	--------------

3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/600,371

Applicant(s)

PEYMAN, GHOLAM A.

Examiner

Dave Willse

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 7,8,20,21,32,33,36-49 and 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-19,22-31,34,35,50 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The terminal disclaimer filed on November 15, 2006, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on U.S. application serial numbers 10/455,788 or 11/038,320 has been reviewed and is **not** accepted.

The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because:

The person who has signed the disclaimer has not stated the extent of his/her interest, or the business entity's interest, in the application/patent (37 CFR 1.321(b)(3)).

The Applicant's remarks with respect to the withdrawal of claims 36-49 have been considered. Figures 13-16 depict optical portions that are generally coaxial, with one portion surrounding the other. Neither Figures 13-16 nor paragraphs **0045** and **0047**, referenced by the Applicant, suggest lens portions that are "*offset* from each other" (e.g., present claim 36, line 6; emphasis added).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claims because the examined application claim is either anticipated by, or would have been obvious over, the reference claims (e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969)).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 9-19, 22-31, 34, 35, 50, and 51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application No. 11/038,320. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the limitations of present claim 1 and others are set forth in or are implicit from copending claims 15, 16, 20, 37, 41, and others. The variants of instant claims 9, 10, 12, and others were known to the ordinary practitioner and would have been obvious in order to provide appropriate prescriptions for different levels of myopia, hyperopia, presbyopia, and/or astigmatism. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-6, 9-19, 22-31, 34, 35, 50, and 51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/455,788. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present features are found in or would have been obvious from such copending claims as 23-25, 30, 36, 37, and 40, for reasons similar to those presented above. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The disclosure is objected to because of the following informalities: In claim 52, line 2, -element-- should be inserted after “optical”, second occurrence. Appropriate correction is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3738

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 13, 34, and 50 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Aharoni et al., US 2006/0004446 A1. Figures 1, 2, and 4 illustrate embodiments comprising a first lens **112** having a high minus portion (paragraphs **0031** and **0032**) and a second lens in the form of air gap **120** or contact lens **12**, the latter element being *capable* of at least partial implantation into the cornea, even though such was not the intent. The first and second lenses supplement the “existing” artificial lens **116** to provide unmagnified and peripherally unrestricted vision (paragraphs **0026** and **0027**) and are *capable* of being used with an external lens of sufficient positive power (whether or not such was the intent) so as to provide magnified and peripherally restricted vision. Regarding claims 4-6, the haptics **102** are *capable* of securing (via sutures or the like) the lens implant to the iris (with or without a portion removed therefrom), even though such was not the intent.

Claims 29 and 30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lipshitz, US 5,391,202, which discloses a first lens having high minus portion **46** and plus portion **41** and a second lens **45** such that the lenses form a teledioptic system (column 1, lines

Art Unit: 3738

44-56; etc.). Regarding claim 30, during the surgical procedure, the first lens is inserted into the anterior chamber of the eye prior to being affixed within the posterior chamber.

Claims 31 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lipshitz, US 5,391,202. The second lens **45** taking the form of a corneal implant would have been obvious in order to further increase the magnification (column 3, lines 25-27) and/or to minimize the incision size (column 3, lines 43-49).

The Applicant's remarks have been considered but are deemed moot in view of the new grounds of rejection, necessitated by the language added to the independent claims. Therefore:

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762 and who is generally available Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Dave Willse
Primary Examiner
Art Unit 3738